



AMENDMENT UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 3711
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Hisashi YAMAGISHI, et al.

Appln. No.: 08/898,853

Confirmation No.: Unassigned

Group Art Unit: 3711

Filed: July 25, 1997

Examiner: Raeann Gorden

For: MULTI-PIECE SOLID GOLF BALL

RESPONSE UNDER 37 C.F.R. § 1.116

ATTN: BOX AF

Commissioner for Patents

Washington, D.C. 20231

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TECHNOLOGY CENTER R3700

Sir:

This response is being submitted to address the Final Office Action dated February 13, 2001 (Paper No. 25), and is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration is respectfully requested.

Claims 1-19 are presently pending in the application. Claims 1-12 are allowed. Claims 13-19 stand rejected under 35 U.S.C. § 112, first paragraph. No prior art rejection remains.

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As a preliminary matter, the undersigned would like to thank the Examiner and her Supervisor for taking the time to conduct the personal Interview of June 6, 2001, wherein the present rejection was discussed.

As agreed in the Interview, claims 14, 15 and 18 had previously been amended to overcome the Examiner's points of rejection for those claims. The Examiner stated in the Interview that the amendments had inadvertently been overlooked and agreed that the amendments will overcome the respective issues for those claims.

With respect to claim 16, the Examiner stated that claim 16 is being rejected solely because it is dependent upon independent claim 13. The issue of the specific gravity disclosure is no longer believed to be a basis for rejection of claim 16.

Thus, the only remaining issue is whether claim 13 meets the § 112, first paragraph requirements. As explained in the Interview, the previous arguments regarding the Higuchi reference were made with respect to claim 1, not claim 13, and the scope of coverage and terminology used in the claims is different. In paragraph 7 of the Office Action the Examiner indicates that the rejection would not be proper if the structure of the outer core layers in both Ohsumi and the present application were the same.

Applicants submit that such is the case here. Both Ohsumi and the present application disclose that this 3rd layer can be an ionomer and both references teach that the Shore D value for this 3rd layer is less than the Shore D value for the intermediate layer. The Examiner's Supervisor maintained in the Interview that there is simply an overlap in some of the

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embodiments of the two structures but that they are not necessarily identical and that there are other aspects of the structure that are not taught to be necessarily the same.

Applicants respectfully submit that every aspect of every embodiment of the 3rd layer need not be identical in the two disclosures. Rather, only the features that pertain to the claim limitations need be the same. And since claim 13 need not cover every embodiment of the application and the Ohsumi reference, it is only pertinent that one embodiment of Ohsumi's claimed 3rd layer be substantially the same as one embodiment of Applicants' claimed 3rd layer.

The layer 12c of Ohsumi and layer 15 of the present application, regardless of what label is put on these layers, are substantially identical with respect to the claim limitations. For example, in Ohsumi at column 2:51, Ohsumi teaches that this layer is preferably made with an ionomer resin. Layer 15 in the Applicants' application also is preferably made with an ionomer resin (page 6:26, 29). In addition, both Ohsumi and the present application include embodiments wherein the Shore D value of this 3rd layer is less than the Shore D value of the second layer from the inner core. Thus, Applicants respectfully submit that the structures of both disclosed 3rd layers are substantially identical despite the difference in terminology used by Ohsumi and the Applicants.

It is therefore believed that Ohsumi provides further evidence that one of the ordinary skill in the art would understand that the "outer layer" of claim 13 is fully supported by the disclosure of layer 15 in the present application. It is therefore submitted that this rejection is improper and Applicants respectfully request that the Examiner withdraw it.

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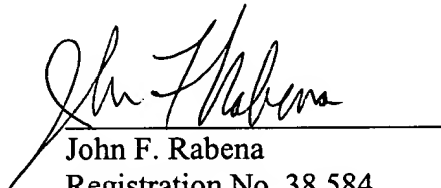
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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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Date: June 13, 2001